

Express Mail No. EV809055811US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants:	Max Aebi et al.	Confirmation No.:	4698
Application No.:	10/539,659		
Int'l Appln. No.:	PCT/CH02/00704	I.A. Filing Date:	December 17, 2002
For:	INTERVERTEBRAL IMPLANT WITH JOINT PARTS MOUNTED ON ROLLER BODIES	Attorney Docket:	8932-1179-999 (new) (formerly LUS-16089)

New York, New York 10017
January 17, 2007

Mail Stop PCT
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Office of PCT Legal Administration

REPLY TO DECISION ON PETITION UNDER 37 C.F.R. § 1.47(a)

Sir:

Applicants hereby reply to the Decision On Petition mailed October 17, 2006 in connection with this case.

To briefly recap, applicants filed on September 14, 2006 a Petition For Filing By Other Than All Inventors Under 37 C.F.R. § 1.47(a) along with a Reply To Notification Of Missing Requirements, a partially-executed Declaration And Power Of Attorney, and related papers.

On October 17, 2006, the USPTO mailed a Decision On Petition dismissing applicants' Petition (copy of Decision enclosed).

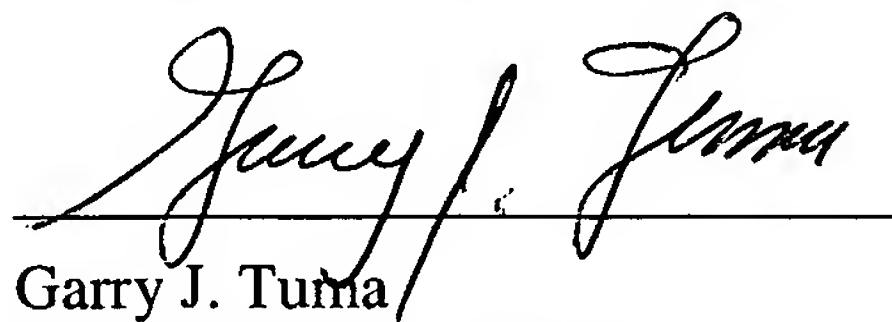
Applicants have since recently received a January 4, 2007 letter and an executed Declaration And Power Of Attorney from previously-uncooperative joint-inventor Max Aebi. Copies of the letter and executed Declaration are also enclosed.

As evidenced by the letter, Mr. Aebi did receive (and refused to execute) the Declaration and application papers previously sent by Ms. McPherson as indicated in her September 13, 2006 Statement Of Facts.

However, in view of applicants' receipt of the executed Declaration by Mr. Aebi, applicants do not renew their Petition For Filing By Other Than All Inventors and, instead, request continued processing of their September 14, 2006 Reply To Notification Of Missing Requirements.

Applicants further enclose herewith a Petition For Extension of Time, extending the time to reply to the Decision On Petition by one month, up to and including January 17, 2007. If other fees are due in connection with this Reply, please charge those fees to Deposit Account No. 50-3013. A duplicate copy of this Reply is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Garry J. Tuma", is written over a horizontal line.

Garry J. Tuma
Registration No. 40,210
Attorney for Applicants

JONES DAY
Customer No. 51832
222 East 41st Street
New York, New York 10017
(212) 326-3939



UNITED STATES PATENT AND TRADEMARK OFFICE

8932-1179-999

G. Tuma / S. Miller

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

17 OCT 2006

Request for Reconsideration
Decision

12-17-06

JONES DAY
222 EAST 41ST STREET
NEW YORK NY 10017-6702

In re Application of
AEBI et al.
Application No.: 10/539,659
PCT No.: PCT/CH2002/000704
Int. Filing Date: 17 December 2002
Priority Date: None
Attorney Docket No.: LUS-16089
For: INTERVERTEBRAL IMPLANT WITH
JOINT PARTS MOUNTED ON ROLLER BODIES

DECISION

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 14 September 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 17 December 2002, applicants filed international application PCT/CH2002/000704, which designated the United States and did not claim a priority date. A copy of the international application was communicated from the International Bureau to the USPTO on 01 July 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 June 2005.

On 14 June 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an English translation of the international application, and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage.

On 14 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 14 September 2006, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a five month extension of time, a declaration of inventors, a declaration of facts by Carrie A. McPherson, a declaration of facts by Garry J. Tuma,

a copy of an e-mail dated 22 August 2006 from Carrie McPherson to non-signing inventor Max Aebi, a copy of a "Delivery Status Notification" for the e-mail; a copy of a letter dated 10 August 2005 from a "P. Kaiser" to a "Mr. Spaw", and a copy of a letter dated 16 August 2005 to Mr. Spaw from a person whose signature is not legible to the undersigned.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3), and (4) have been satisfied.

Item (2) has not been satisfied. MPEP § 409.03(d) states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Here, it is not clear that a copy of the application papers including the specification, claims and drawings was sent to the last known mailing address of Mr. Aebi. Although an e-mail copy was sent to the last known e-mail address of Mr. Aebi, it is not clear whether Mr. Aebi received the e-mail. (The "Delivery Status Notification" only confirms delivery, not receipt.) "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." MPEP 409.03(d).

Additionally the declaration of facts of Mr. Tuma states that Mr. Aebi was already refusing to sign any papers related to the above-identified patent application as of August 2005. Copies of letters to a Mr. Spaw are provided as support. However, it is not clear whether the statement in the letter of 10 August 2005 that Mr. Aebi "is not willing to sign" is based on an express refusal by Mr. Aebi or whether this statement is a conclusion based on Mr. Aebi's conduct. If the refusal was express, attention is directed to MPEP § 409.03(d) which states in part:

When there is an express oral refusal, that fact along with the time and place of the refusal must be

stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

If the refusal was not express but is based on Mr. Aebe's conduct, attention is directed to the following section MPEP § 409.03(d):

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer

Legal Examiner

PCT Legal Affairs

Office of Patent Cooperation Treaty

Legal Administration

Telephone: (571) 272-3301

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Mr. Robert M. Rauker, Esq.
Vice President, Chief Patent Counsel
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1302 Wrights Lane East

West Chester, Pennsylvania 19380

U.S.A.

Medizinische Fakultät
MEM Forschungszentrum
Institut für Evaluative Forschung
in Orthopädischer Chirurgie

Bern, January 4th, 2007 Ae

Re.: U.S. Patent Application No. 10/539,659 (filed June 14, 2005)
Corresponding to PCT/CH02/00704 (filed December 17, 2002)
Titled „Intervertebral Implant With Joint Parts Mounted On Roller Bodies“
(00070-05PUS1; 8932-1179-999; LU1981)

U.S. Patent Application No. 10/539,660 (filed June 14, 2005)
Corresponding to PCT/CH02/00705 (filed December 17, 2002)
Titled „Intervertebral Implant With Tilttable Joint Parts“
(00093-05PUS1; 8932-1180-999; LU1982)

U.S. Patent Application No. 10/538,542 (filed June 10, 2005)
Corresponding to PCT/CH02/00706 (filed December 17, 2002)
Titled „Intervertebral Implant Comprising Joint Parts That Are Mounted To
Form A Universal Joint“
(00083-05PUS1; 8932-1181-999; LU1983)

U.S. Patent Application No. 10/538,950 (filed June 14, 2005)
Corresponding to PCT/CH02/00707 (filed December 17, 2002)
Titled „Intervertebral Implant“
(00082-05PUS1; 8932-1182-999; LU1984)

Dear Mr. Rauker,

I apologize for the delay of signing the declaration and power of attorney, but due to my situation with my Employer Universities I was waiting for advise from them what to do.

Please find now enclosed the duly signed Power of Attorney as requested. Please note that I agree that Jones Day will continue to prosecute the four patent applications listed in your letter of December 19, 2006, on behalf of the assignees.

Prof. Dr. med. et h.c. Max Aebi
MEM Stiftungsprofessor und Direktor
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max.aebi@MEMcenter.unibe.ch
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I am at your disposition for any further questions or information.

Sincerely,



M. Aebi

cc:

- Office of Technology Transfer, McGill University
- Dr. H. Reutimann, Office of Technology Transfer, University of Bern,
Law office for patent application
- Jones Day, 222 East 41st Street, New York, NY 10017 / USA

BEST AVAILABLE COPY

DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below at 201 et seq. beneath my name.

I believe I am the original, first and sole inventor if only one name is listed at 201 below, or an original, first and joint inventor if plural names are listed at 201 et seq. below, of the subject matter which is claimed and for which a patent is sought on the invention entitled

INTERVERTEBRAL IMPLANT WITH JOINT PARTS MOUNTED ON ROLLER BODIES

and for which a patent application:

☒ was filed in the United States on June 14, 2005 as Application No. 10/539,659 and amended on even date, said application being a National Stage of:

☒ PCT International Application No. PCT/CH02/000704, filed on December 17, 2002

I hereby state that I have reviewed and understand the contents of the above identified application, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

EARLIEST FOREIGN APPLICATION(S), IF ANY, FILED PRIOR TO THE FILING DATE OF THE APPLICATION				
APPLICATION NUMBER	COUNTRY	DATE OF FILING (day, month, year)	PRIORITY CLAIMED	
			YES <input type="checkbox"/>	NO <input type="checkbox"/>
			YES <input type="checkbox"/>	NO <input type="checkbox"/>

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

PROVISIONAL APPLICATION NUMBER	FILING DATE

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code § 112, I acknowledge the duty to disclose information known to me which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

NON-PROVISIONAL APPLICATION NO.	FILING DATE	STATUS		
		PATENTED	PENDING	ABANDONED

POWER OF ATTORNEY: As a named inventor, I hereby appoint the Practitioners of Customer Number 51832, whose address is Jones Day, 222 East 41st Street, New York, New York 10017, my attorneys, to prosecute this application, and to transact all business in the Patent and Trademark Office connected therewith.

SEND CORRESPONDENCE TO:		JONES DAY 222 East 41st Street, New York, NY 10017 PTO Customer No. 51832		DIRECT TELEPHONE CALLS TO: JONES DAY DOCKETING 212-901-9028	
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.					
2 0 1	FULL NAME OF INVENTOR	LAST NAME Aebi	FIRST NAME Max	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bern	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Gerechtigkeitsgasse 48	CITY Bern	STATE OR COUNTRY Switzerland	ZIP CODE CH-3011
	SIGNATURE OF INVENTOR 201			DATE Jan 3, 2007	
2 0 2	FULL NAME OF INVENTOR	LAST NAME Frigg	FIRST NAME Robert	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Mattenweg 8	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 202			DATE	
2 0 3	FULL NAME OF INVENTOR	LAST NAME Burkard	FIRST NAME Dominique	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Gretzenbach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Hasengasse 6	CITY Gretzenbach	STATE OR COUNTRY Switzerland	ZIP CODE CH-5014
	SIGNATURE OF INVENTOR 203			DATE	
2 0 4	FULL NAME OF INVENTOR	LAST NAME Lechmann	FIRST NAME Beat	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Grenchenstrasse 29a	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 204			DATE	

2 0 5	FULL NAME OF INVENTOR	LAST NAME Pavlov	FIRST NAME Paul	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Nijmegen	STATE OR FOREIGN COUNTRY Netherlands	COUNTRY OF CITIZENSHIP Netherlands	
	POST OFFICE ADDRESS	STREET Louiseweg 5	CITY Nijmegen	STATE OR COUNTRY Netherlands	ZIP CODE NL-6523
	SIGNATURE OF INVENTOR 2-5			DATE	
2 0 6	FULL NAME OF INVENTOR	LAST NAME Mathys Jr.	FIRST NAME Robert	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Bettlach	STATE OR FOREIGN COUNTRY Switzerland	COUNTRY OF CITIZENSHIP Switzerland	
	POST OFFICE ADDRESS	STREET Chrütziacherstrasse 11	CITY Bettlach	STATE OR COUNTRY Switzerland	ZIP CODE CH-2544
	SIGNATURE OF INVENTOR 2-6			DATE	